

LAW OFFICES  
**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.**  
1300 I Street, N.W.  
Washington, DC 20005-3315

Telephone  
(202) 408-4000

Facsimile  
(202) 408-4400

---

**FACSIMILE TRANSMITTAL**

**TO:**

**Name:** Examiner D. Brunzman.

**Firm:** United States Patent  
and Trademark Office

**Fax No.:** 703 872 9049

**Phone No.:** 703 308 3454

**Subject:** Serial No. 08/544,212  
Our Ref.: 01222.0034-00000

**FROM:**

**Name:** Robert J. Eichelburg, Esq.

**Phone No.:** 202-408-4026

**Fax # Verified by:** M.K. Leftwich

**# Pages (incl. this):** 4

**Date:** February 12, 2001

**Confirmation Copy to Follow:** No

---

**Message:**

If there is a problem with this transmission, notify fax room at (202) 408-4174 or the sender at the number above.

---

This facsimile is intended only for the individual to whom it is addressed and may contain information that is privileged, confidential, or exempt from disclosure under applicable law. If you have received this facsimile in error, please notify the sender immediately by telephone (collect), and return the original message by first-class mail to the above address.

PATENT

Attorney Docket No. 01222.0034-00000

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: )

David A. Russo et al. )

Serial No.: 08/544,212 )

Group Art Unit: 1755

Filed: October 17, 1995 )

Examiner: D. Brunsman

For: COATING COMPOSITION )  
FOR GLASS )Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

**MEMORANDUM OF ISSUES TO BE DISCUSSED AT ORAL  
INTERVIEW AND WHY APPLICANTS BELIEVE AN INTERVIEW  
WOULD HELP THE PROSECUTION OF THE APPLICATION**

Applicants' attorney telephoned the Examiner on February 5, 2001 requesting an oral interview, but the Examiner requested that applicants present a memorandum of issues to be discussed at an oral interview, and why the interview would help advance the prosecution of the application. Applicants' attorney offers the following remarks in this regard.

**Applicants' Reasons Why an Interview would be helpful  
to Advance the Prosecution of the Application**

The assignee of the application has requested a personal interview with the Examiner and will attend the interview if granted.

Applicants' assignee and their attorney believe that because of the complexity of the issues raised in this reissue application, and the multiple rejections and responses exchanged starting with the July 1, 1996 Office Action up and through the present October 26, 2000 Office Action, a discussion of the issues at an oral interview will streamline the prosecution and hopefully bring it to a conclusion.

### Issues

Applicants' attorney will discuss the following classes of claims to show that the recapture doctrine does not bar their issuance:

<u>Type of Claim</u>	<u>Claim</u>
Composition of matter claims	Claims 1-27, 28,29, 31, 32
Oxide film claims that do not specify a silicon oxide or its precursor but are broad enough to include them	Claims 33-36, 38, 50-52
Oxide film claims that do not specify a silicon oxide or its precursor but are broad enough to include them on a substrate	Claims 39-49
Oxide films with a silicon oxide	Claims 37,56-60
Product by process claims	Claims 65 and 66 directed to an oxide composition produced by oxidizing the composition of any one of claims 1-29 and 31-32

Applicants will offer reasons why the decision, In re Clement, 131 F.3d 1464, 45 U.S.P.Q. 2nd 1161 (Fed. Cir. 1997) does not apply to invoke the recapture rule, and how in Clement, the Court showed how they derived their recapture criteria from the earlier decisions, Ball Corp. v United States, 729 F.2d 1439, 221 U.S.P.Q 289 (Fed. Cir. 1984) and Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 27 U.S.P.Q. 2nd 1521 (Fed. Cir. 1983).


Applicants' attorney will also offer reasons why MPEP §1412.02 regarding standards employed in a recapture rejection does not apply.

Applicants therefore respectfully request that the Examiner grant an oral interview.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:

  
R. J. Eichelburg  
Reg. No. 23,057

Dated: February 12, 2001

LAW OFFICES  
FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000